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3903

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/944,915

Applicant(s)

WESTENDORF ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/10/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 22-48 are pending.
2. Applicant's response filed 07/10/2007 has been received and considered.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: nowhere in the specification is it described that the check result is not used to process the first data or that the check result is Boolean.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 47 and 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe that the check result is not used to process the first data nor does it disclose that it is used to process the first data. However, the mere absence of a positive recitation is not basis for exclusion. See MPEP 2173.05(i). Furthermore, the specification makes no mention of any Boolean terms. Therefore the claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

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States and was published under Article 21(2) of such treaty in the English language.

7. Claims 22-24, 26-28, 31-34, 36, and 39-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Peinado et al. (US 7051005).

As per claims 22, 23, 41-45, and 47 Peinado et al. discloses transmitting first data to a first processor from one of a data medium drive and a third processor (see column 2 lines 41-56); transmitting second data to a second processor, the second data being based on the first data; checking the second data in the second processor to determine if the first data may be processed in the first processor (see column 3 lines 10-43); transmitting a positive check result to the first processor (see column 3 lines 31-43); and responsive to receiving the positive check result, processing the first data at the first processor (see column 3 lines 44-54).

As per claim 24, Peinado et al. discloses the limitations substantially similar to those of claim 22 and further discloses, wherein the step of transmitting the first data include transmitting the first data to the first processor from a data medium drive, and wherein the method further comprises: checking in the second processor an identity of a data carrier in the data medium drive (see column 3 lines 31-43).

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As per claim 26, Peinado et al. discloses checking an error-free transmission in at least one of the first processor and the second processor (see column 2 line 66 through column 3 line 5).

As per claims 27 and 28, Peinado et al. discloses the data is transmitted in encoded form (see column 2 line 66 through column 3 line 5).

As per claims 31, 33-34 and 36, Peinado et al. discloses accessing a database and allowing and storing data (see column 3 lines 31-43).

As per claim 32, Peinado et al. discloses, initiating by the second processor a payment process as a function of the second data (see column 20 lines 51-60).

As per claims 39 and 40, Peinado et al. discloses determining a first check code is determined from the first data; and forming the second data at least in part from the first check code (see column 2 line 66 through column 3 line 43).

As per claim 47, Peinado discloses the check result is not used to process the first data (see column 19 lines 12-27 where the request is refused the data cannot be used).

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***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. as applied to claim 22 above, in view of Okada (US 6704872).

As per claim 25, Peinado et al. discloses transmitting the first data to the first processor from a third processor (see column 2 lines 45-60 and figure 1), but fails to disclose including an identity of the processor with the authentication information.

However, Okada teaches including such information (see Abstract).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to including the identity of the processor with the information of Peinado et al.

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Motivation to do so would have been to restrict the use of a specific software program to a single processor (see Okada abstract).

10. Claims 29, 30 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al.

As per claims 29 and 30, Peinado et al. fails to disclose the use of wireless connections.

However, Official Notice is taken that at the time of the invention it would have been obvious to one of ordinary skill in the art to use wireless connections.

Motivation to do so would have been to allow for mobility.

As per claim 47, Peinado fails to disclose that the check result is Boolean.

However, Official Notice is taken that at the time of the invention it would have been obvious to one of ordinary skill in the art to use a Boolean for a check result.

Motivation to do so would have been its simplicity to implement.

11. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. as applied to claim 22 above, in view of Gurr (US 4264960).

As per claim 35, Peinado et al. fails to disclose starting a check of the first data in the first processor; and restarting



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the check in the first processor if the check has not been run through completely.

However, Gurr et al teaches such a check (see column 16 line 52 through column 17 line 3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the checking system of Gurr in the Peinado et al. system.

Motivation to do so would have been to check a message for errors (see Gurr column 16 line 52 through column 17 line 3).

12. Claims 37 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. as applied to claim 22 above, in view of Coley et al. (US 5790664).

As per claim 37, Peinado et al. fails to disclose deleting data if there is no license.

However, Coley et al. teaches such a practice (see column 14 lines 57-67).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to delete the content of Peinado et al. if there is no license.

Motivation to do so would have been to protect the data from unauthorized use (see Coley et al. column 14 lines 57-67).

As per claim 46, the modified Peinado et al. and Coley et al. system discloses the checking is executed at specifiabile

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time intervals (see column 8 lines 54-69 and column 9 lines 1-22 and 42-51).

13. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peinado et al. as applied to claim 22 above, in view of Flick (US 6140939).

As per claim 38, Peinado et al. fails to disclose delivering a warning if the first data is not released.

However, Flick teaches such a warning (see column 3 lines 7-23).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the warning of Flick in the system of Peinado et al.

Motivation to do so would have been to allow for updating of samples (see column 3 lines 7-23).

#### ***Response to Arguments***

14. Applicant's arguments filed 07/10/2007 have been fully considered but they are not persuasive. Applicant argues that Peinado fails to disclose a method where the second processor transmits a check result and the remaining references fail to cure this deficiency.

With respect to Applicant's argument that Peinado fails to disclose a method where the second processor transmits a check

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result, the information sent from the licensing server (e.g. the encrypted decryption key) tells the first processor (i.e. the client) that it has permission to process the data using the information (see column 3 lines 11-43). The refusal (as described in column 19 lines 12-27) to send this information is an indication that the check has failed and the first processor does not have permission to process the first data. Therefore, Peinado discloses a method where the second processor transmits a check result. Applicant's argument that the remaining references fail to cure this deficiency is moot in view of this response.

### **Conclusion**

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

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from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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